

THIS DISPOSTION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

Hearing:
June 25, 1996

Paper No.
JER

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gridiron Enterprises, Inc.

Serial Nos. 74/249,309; 74/249,318;
and 74/249,469

John P. Bouxsein, III and William L. Niro of Niro, Scavone,
Haller & Niro and Mark M. Newman of Barnes & Thornburg for
applicant.

Michael C. Mason, Trademark Examining Attorney, Law Office
101 (R. Ellsworth Williams, Managing Attorney).

Before Rice, Hanak, and Hairston, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

Applications have been filed by Gridiron Enterprises,
Inc. to register, on the Principal Register under the
provisions of Section 2(f) of the Trademark Act of 1946, 15
U.S.C. §1052(f), the designations ARENA FOOTBALL,¹ ARENA
FOOTBALL and design,² as shown below (in reduced size),

¹ Serial No. 74/249,469. Applicant has disclaimed the word
FOOTBALL apart from the mark as shown.

² Serial No. 74/249,309. Applicant has disclaimed the word
FOOTBALL and the design of a football apart from the mark as
shown.



and ARENA,³ all for entertainment services in the nature of organizing, scheduling and conducting football games. Each of the applications was filed on February 25, 1992, with a Section 2(f) claim of distinctiveness, and in each applicant claims first use and first use in commerce on April 27, 1986.

With respect to the designations ARENA FOOTBALL and ARENA, registration has been finally refused under Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1), on the ground that the designations, as used in connection with applicant's services, are merely descriptive of them and have not become distinctive but are, instead, generic.⁴ For

³ Serial No. 74/249,318.

⁴ Registration was also initially refused, in all three applications, under Section 2(d) of the Act, 15 U.S.C. 1052(d), on the ground that applicant's designations, as used in connection with its services, so resemble the marks in two cited

the same reasons, the Examining Attorney has made final a requirement, with respect to the designation ARENA FOOTBALL and design, that applicant disclaim the words ARENA FOOTBALL apart from the mark as shown.⁵ Applicant has appealed.

Prior to the filing of briefs, the three cases were consolidated at the request of the Examining Attorney. Accordingly, they were briefed and argued together, and are being decided together in a single opinion.

The issues to be determined herein are (1) whether the terms ARENA FOOTBALL and ARENA are generic with respect to applicant's services, and, if not, (2) whether they have become distinctive of those services.⁶

registrations as to be likely to cause confusion, or to cause mistake, or to deceive. The two cited registrations were Registration No. 1,540,429, issued May 23, 1989 from an application filed October 7, 1987, for the mark ARENABALL for a magazine on the subject of indoor football and for organizing and promoting football exhibitions, and Registration No. 1,602,917, issued June 19, 1990 from an application filed January 20, 1988, for the mark ARENABOWL for organizing and promoting football exhibitions. The refusal to register on this ground was withdrawn when applicant claimed ownership of the registrations. A refusal to register all three designations on yet another ground, namely, lack of ownership of the designations, was also eventually withdrawn, leaving only the refusal described above to be determined herein.

⁵ Applicant has disclaimed only the word FOOTBALL and the football design.

⁶ There is no question that the terms ARENA FOOTBALL and ARENA are merely descriptive as used in connection with applicant's services. In recognition of the merely descriptive nature of these terms, applicant sought registration under the provisions of Section 2(f) from the outset. The inclusion of a claim of acquired distinctiveness in an application as originally filed constitutes, in effect, a concession by applicant that the designation it seeks to register is merely descriptive of its goods or services. See *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994), and cases cited therein. In the same vein, applicant has stated, on page 1 of a response filed on August 5, 1994 in application Serial No. 74/249,318 (the application to register ARENA), "Applicant has already admitted

In each application, applicant has submitted as specimens copies of a brochure which bears, inter alia, the designation ARENA FOOTBALL and design (sought to be registered in application Serial No. 74/249,309) and the title "1991 MEDIA GUIDE." The brochure includes certain background information (on pages 4-5, under the headline "ARENA FOOTBALL HISTORY") which is helpful in understanding these cases. Portions of this text are quoted below:

In 1985, Jim Foster brought life to an intriguing idea he had nurtured since early 1981. Foster, a successful pro football marketing management veteran with experience in the NFL, USFL, American Football in Europe and the Major Indoor Soccer League, had created a unique new game of indoor pro football that did not imitate the established outdoor game.

"If they can play soccer indoors, why not football?" reasoned Foster. While watching his first indoor soccer game in Madison Square Garden in 1981, Foster pulled a large manilla envelope from his briefcase, drew the outline of a miniature football field over a hockey rink and penciled in notes on what would evolve into a full-fledged concept of a curiously new and exciting adaptation of America's favorite team

that as applied to football competitions, 'arena' is descriptive as the competitions are or could be played in an arena and thus submitted evidence of distinctiveness." We agree. A mark is merely descriptive if, as used in connection with the goods or services in question, it describes, i.e., immediately conveys information about, an ingredient, quality, characteristic, feature, etc. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978), and *In re Eden Foods Inc.*, 24 USPQ2d 1757 (TTAB 1992). Applicant's services are identified in its applications as entertainment services in the nature of organizing, scheduling and conducting football games. The fact that those football games are or could be played in an arena (indeed, the record is replete with references to the playing of these games in arenas) is a significant characteristic or feature of the services. Under the circumstances, we have no doubt that the terms ARENA FOOTBALL and ARENA are merely descriptive of applicant's services.

sport. He began with a proven concept, American football, and, knowing there was no room for competition with the NFL, decided instead to hypothesize an indoor and summertime hybrid. He applied the best of the gridiron game with new and interesting twists: a 50-yard field, eight vs. eight, single-platoon, drop kicks and rebound nets.

In 1985, after the rise and fall of the USFL, Foster decided to move forward with the development of indoor football. The first step was to make sure that football could be executed indoors on a much smaller playing surface. ... The next step was to measure response from the public and sports media through a test game in April, 1986 in Rockford, Illinois. The initial response was excellent. A second "showcase" game in Chicago, on Feb. 26, 1987, was enthusiastically received by 8,200 fans, and that set the stage for the full-fledged rollout of Arena Football in June, 1987.

* * *

The first year a small staff of league employees successfully took an exciting new concept in pro football to sports fans of America with the assistance of four well-operated arenas in Denver, Chicago, Pittsburgh and Washington D.C. The arenas supported the effort with local marketing and public relations. ...

* * *

... The final issuance of a U.S. patent to Jim Foster for the Arena Football Game system on Marh 27, 1990, made the Arena Football League the only sports league in history to play a patented game. This also greatly strengthened the value of buying an Arena Football team license and, as a result, six successful businessmen committed, in late March 1990, to form a stronger, reorganized league. The future of Arena Football brightened with the stability of the patent and the introduction of established local ownership. ...

Arena Football delivers, in one dazzling package, tough, gritty competition, cagey strategy and

fast-paced action that is close to the fans. ...
It is a truly different game than the NFL. ...
Arena Football has arrived. It is an emerging
summertime pro sports offering that provides
football fans with an exciting and unique indoor
air-conditioned version of their favorite game
on hot weekend summer nights.

In support of the refusal to register, the Examining Attorney has made of record a large number (approximately 180) of representative story excerpts from the DATATIMES and NEXIS databases, as well as an encyclopedia entry. In addition, the Examining Attorney points to some of applicant's own uses.

Turning first to applicant's own uses, the Examining Attorney refers to several different items submitted by applicant. In the specimen brochure entitled "1991 MEDIA GUIDE," the Examining Attorney notes the following sentences (**emphasis** added) which appear in a section captioned "RULES AND REGULATIONS" appearing on pages 49-52:

There are no offensive tackles in **Arena Football**.
(page 49)

The average elapsed time for an **Arena Football**
game is about 2 hours and 15 minutes. (page 50)

Passing rules in **Arena Football** are the same as
in outdoor football, with one exception. (page 50)

The rules of **Arena Football** will be subject to
regular review and possible minor modification by
a qualified Competition and Rules Committee
appointed by the League. (page 52)

With respect to a promotional sheet submitted by
applicant,⁷ the Examining Attorney notes that the sheet

⁷ The promotional sheet was submitted in application Serial No. 74/249,469 with a request for reconsideration filed September

bears at its top applicant's designation ARENA FOOTBALL and design and adjacent thereto the phrase "MORE THAN JUST A GAME...It's an Event!" The Examining Attorney also points to the following sentence (emphasis added) in the text of the sheet: "Combining the best elements of the outdoor game with the scoring potential of the short field, **Arena Football** is thrilling fans across the country, and around the world!"

Finally, applicant has submitted a number of different issues of its ARENABALL game magazine. With respect to the May 28, 1993 Texans vs. Detroit game issue,⁸ the Examining Attorney notes that page 1 bears at its top applicant's designation ARENA FOOTBALL and design with the slogan "The 50 Yard Indoor War" immediately adjacent thereto, and that the text below includes the sentence (**emphasis** added), "In the beginning, our teams faced a difficult challenge in attracting versatile athletes to handle the unique two-way challenges of **Arena Football**." Other sentences in the magazine to which the Examining Attorney calls attention are listed below (**emphasis** added):

In 1981, Jim Foster invented **Arena Football** while watching an indoor soccer game at Madison Square Garden. (page 5)

20, 1993, and in the other two applications (where it appears as Exhibit 2 to a declaration by Jerry B. Kurz) with a request for reconsideration filed May 9, 1995. According to applicant's counsel, the promotional sheet is intended for distribution to sponsors and advertisers.

⁸ The issue was submitted in application Serial No. 74/249,469 with applicant's request for reconsideration filed September 20, 1993.

In 1988, sports illustrated [sic] writer, Paul Zimmerman watched his first **Arena Football** game in Chicago. After viewing the game, Zimmerman commented to several league officials that comparing the demands and skills of an **Arena Football** player to those of an outdoor professional football player would be.... (page 11)

But I know several NFL players who could not play **Arena Football**. (page 11)

O'Hara envisions a day when there will be two distinct seasons of **Arena Football** in the same calendar year. (page 60)

... the game of **Arena Football** is not as easy as it seems ... players come away amazed at the skills that are needed to play **Arena Football**. (page 60)

In addition, the Examining Attorney notes that the "Rules and Regulations" section of applicant's ARENABALL magazine has usages similar to those in the same section of the 1991 MEDIA GUIDE.⁹

We turn next to the DATATIMES and NEXIS database story excerpts made of record by the Examining Attorney.¹⁰ The

⁹ The usages cited by the Examining Attorney are not the only such usages made by applicant in the materials of record, but are illustrative thereof.

¹⁰ As noted above, there are approximately 180 of these excerpts, said by the Examining Attorney to be representative of the much larger number of excerpts found in the database searches. Approximately 8 of the story excerpts appear to come from foreign publications. In the absence of evidence as to the extent of circulation, if any, of these publications in the United States, they are not probative of the significance of ARENA FOOTBALL and ARENA in the United States. See *In re BDH Two Inc.*, 26 USPQ2d 1556 (TTAB 1993). Accordingly, we have disregarded the story excerpts that appear to be from foreign publications. In addition, there are about 11 duplicate story excerpts. We have considered these only once. Also, there are approximately 10 story excerpts where the pertinent usage appears in a headline or in the specification of the newspaper section in which the story in question appears, and the entire

greatest number of these story excerpts contain what are, to our eyes, generic usages. Examples of these usages are given below (**emphasis** added):

...200 tags suggested by fans in a name-the-team contest for the Washington entry in the new sport of **arena football**. The Washington Post 5/7/87

Meanwhile, Cline's firm will pursue sports such as major-league baseball, college football and even **arena football** for the Suncoast Dome,... St. Petersburg Times 9/8/87

The KBYG schedule includes call-in sports talk from 2 to 6 p.m. and 9 p.m. to midnight, as well as **arena football**, high-school sports,... Denver Business 10/87

This winter the NFL owners will have the opportunity to relegate instant replay to the garbage heap of dopey sports concepts (where things like **arena football**, triathlons and synchronized swimming belong). USA TODAY 1/20/89

There are other breaks in the year, but this is the only time there's no other sports going on. ... No Canadian football, no **arena football**, no nothing. USA TODAY 7/13/89

Louisville someday could get another pro sports

headline or section specification is in capital letters. In most of these, we can draw no real conclusion as to the nature of the use. Three of the story excerpts contain usages of ARENA FOOTBALL LEAGUE, rather than ARENA FOOTBALL. These are not pertinent. Finally, approximately 13 of the excerpts appear to be stories from wire services. Because these proprietary releases are primarily circulated to newspapers and news journals rather than to the general public, they are of very limited probative value for purposes herein. See *In re Manco Inc.*, 24 USPQ2d 1062 (TTAB 1992). For purposes of simplicity, our discussion above is based upon the remaining story excerpts (of which there are approximately 135). We note that the usages in the wire service excerpts are, in any event, very similar in nature (and proportion) to those revealed in the 135 story excerpts discussed above.

franchise, perhaps in soccer or **arena football**, they said. The Courier-Journal 7/18/91

Sports programs also include **arena football** from around the country and U.S. Basketball League games. Electronic Media 8/19/91

Jaffe, 28, wrote stories about a similarly broad range of sports, from baseball to crew to **arena football**. Sports Illustrated 9/23/91

Another sport Rubens thinks would do well in Grand Rapids is **arena football**, which is played during the summer months. Grand Rapids Business Journal 11/1/91

"Maybe they (Anaheim officials) can get an **arena football** team or tractor pulls," he said of sports options currently available. Los Angeles Times 3/8/92

... grand concrete and fiberglass circus tent in St. Petersburg's depressed downtown, largely empty except for exhibition sports events, **arena football**, tractor pulls and concerts. The San Francisco Chronicle 8/8/92

24,445 tickets were sold for the July 13 **arena football** game, Denver vs. Tampa Bay. St. Petersburg Times 10/4/92

... the Joe Louis Arena is perfect for basketball, circuses, wrestling, **arena football**, etc. The Detroit News 10/8/92

DeSandy said the Radisson Pontchartrain is filling rooms next year by pushing its family reunion business and is also using its proximity to Cobo Hall and Joe Louis Arena as an edge in booking guests in town because of indoor soccer, **arena football** and other sporting events. Crains Detroit Business 10/12/92

This was one of those nights when it would have made more sense to move the Springsteen concert to the Metrodome and have Target Center turn the Gophers-Hoosiers into an **arena football** game. Star Tribune 11/1/92

...actually hit a receiver to complete a pass --

a tricky maneuver. In retrospect, however, it was no worse than **arena football**. The Hartford Courant 12/11/92

Pittsburgh, Detroit and ourselves now have an interest in **arena football** and we want to talk about dates. The Hartford Courant 12/13/92

Among events would be **arena football**, concerts, family shows, more Bandits indoor lacrosse games and NCAA basketball games.... Buffalo News 2/17/93

The latest indoor sports failure to stumble in Sacramento is **arena football**. The sport's quick demise.... The Business Journal-Sacramento 4/5/93

Of course, we've got real pro sports: baseball, hockey, basketball and football - and **arena football**. Orlando Sentinel Tribune 5/26/93

Its programming mix will include National Hockey League games and college basketball, as well as such relatively exotic sports as **arena football**, beach volleyball, snow boarding and sky-surfing. The San Francisco Chronicle 7/15/93

In addition to hockey, sports such as indoor soccer, minor league basketball and **arena football** have been mentioned as possible area tenants. The Times-Picayune 9/14/93

... are team physicians for the Cleveland Crunch soccer team and the Cleveland Thunderbolts **arena football** team. The Plain Dealer 9/19/93

There was no practice, no preseason game, no prefab sport such as **arena football**. St. Petersburg Times 10/10/93

... he, Coffey, and others interested in making the city exciting are talking about bringing sports such as Triple A baseball and **arena football** here. Kerski described **arena football** as a game in which the football bounces off the walls. The Hartford Courant 2/7/94

To ensure more dates, a Suns subsidiary created

professional sports franchises in **arena football**, team tennis and indoor soccer to play there.
Business First - Columbus 2/14/94

Winter sports purists sometimes equate mogul skiing to **arena football**. The Dallas Morning News 2/17/94

The United States has embraced such professional sports oddities as **arena football** but has yet to latch onto a sport that has prospered for hundreds of years. The Orlando Sentinel 5/22/94

... other summer programming is not promising unless you enjoy roller hockey, cycling, water sports or **arena football**. The last will include three appearances by the Massachusetts Marauders.... The Boston Globe 5/22/94

The network also will show **arena football**, Canadian football and boxing. Star Tribune 8/12/94

But the Garden owners could try and attract minor sports that are gaining a following, such as **arena football** (which was tested at the Garden in the late 1980s but failed), indoor lacrosse and soccer and in-line roller hockey.
Newsday 9/2/94

... the emergence of new leagues and new sports like indoor soccer, **arena football** and roller hockey.... The Washington Post 9/23/94

Scheer says the coliseum's pro sports bookings will be limited to hockey and **arena football**.
The Virginian-Pilot (Norfolk) 11/1/94

Welcome to stadium sailing, the latest attempt - in the grand tradition of **arena football**, indoor soccer and miniature golf - to contain outdoor sports within four walls and a ceiling. Chicago Tribune 1/30/95

We wanted to know if the baseball and hockey lockouts were necessary -- they weren't -- why such minor sports as **arena football** can make money while owners of many big-league franchises can't. Financial World 2/14/95

One new feature of interest to sports fans will be the summer's planned introduction of **arena football**. The game is played on a 50-yard field. Omaha World Herald 4/16/95

As long as the Stampede management remembers that this is a niche sport, creates memorable events and avoids delusional thoughts, **arena football** has a chance here. St. Louis Post-Dispatch 5/14/95

Going into the NBA and NHL playoffs, with baseball in full bloom, the average sports fan had 60 teams to follow. And that's not counting **arena football**, roller hockey, golf, tennis, track and field, various college and high school sports and, for you exotics, the WWF. The San Francisco Examiner 5/19/95

... Tampa to Orlando in 1991 - just in time to try out for an expansion team in this bizarre sport known as **arena football**. The Orlando Sentinel 6/23/95

I wouldn't miss the Extreme Games on ESPN and ESPN2 You'll never convince me that as a TV sport, street luge racing is on par with **arena football**. The Virginian-Pilot (Norfolk) 7/4/95

Of particular interest, in terms of generic uses, are the following story excerpts, each of which demonstrates generic use of ARENA FOOTBALL in connection with activities which have no connection to applicant:

It's a Tuesday night and as part of their weekly activity, the scouts from Troop 700 are playing **arena football** in the gym at Rolling Road School in Catonsville. The Washington Post 6/25/92

When Rick Hosea stands in the middle of his unique, 12,000-square-foot home, he ... sees the fun his three children and their friends have playing soccer, basketball, football, tennis and whatever else they can dream up on the spacious 108-by-60-foot indoor playing field. ... Travis Hosea said he likes to invite his McNicholas football teammates for a game of **arena football**.

The Cincinnati Enquirer 1/28/93

Ken Davis, supervisor of financial reporting for American Express, plays amateur **arena football** in his spare time. The Arizona Republic 1/31/93

Urban Culture reports on popularity of new Miami (Fla)-area amateur league sport of **arena football**. Miami Herald 6/20/93

The DATATIMES and NEXIS database story excerpts also include a smaller number of examples of uses in which the first letters of the words ARENA FOOTBALL are capitalized, or in which the first letter of ARENA is capitalized. Examples of uses in which both first letters are capitalized are given below:

Arena Football, the made-for-television sport that has been getting good ratings on ESPN, may be coming to Los Angeles. Los Angeles Times 7/17/87

Are football fans fanatic enough to go for a scaled-down summer version of their favorite sport? Apparently they are, judging from the early success of **Arena Football**. So what if the game is played indoors.... ADWEEK 11/2/87

Soon, though, he had begun serious discussions to launch his new product. He called the sport **Arena Football**. ... Last summer the Arena Football League staged what it called a "Preview Season." Newsday 4/30/88

Look for an announcement soon concerning **Arena Football**. Jim Foster, founder of the sport, is said to be ready to emerge with a series of exhibitions.... Chicago Tribune 5/24/89

Like mosquitoes and ants, Jim Foster's **Arena Football** just won't disappear. Foster, who invented the sport.... Chicago Tribune 11/14/89

... today when athletes in every sport except **Arena Football** make at least a million annually.

The Washington Times 6/27/90

"For **Arena Football** to come in there and not do any marketing would have been quite risky," Foster said. St. Petersburg Times 7/5/91

That wasn't the case with **Arena Football**; it was its own sport. St. Petersburg Times 7/17/91

Arena Football players certainly are not in the sport for financial gain. Orlando Sentinel Tribune 8/24/92

"I know the kids feel the pressure of being defending champs," said Orrico, who succeeded Gene Nudo, who took a position with **Arena Football**. Chicago Tribune 9/6/92

It was **Arena Football** outdoors, records falling like shooting stars at the Florida Citrus Bowl, a night the Knights of the University of Central Florida were indeed mighty Orlando Sentinel 9/6/92

On a recent trip to Paris, the Orlando Predators gave a team of Europeans a lesson in **Arena Football** and a 71-22 beating. USA TODAY 12/10/92

McCombs, who also owns the Spurs, was so positive about **Arena Football** he said he might want to get back into the sport in the future. The Hartford Courant 12/20/92

And you can't play **Arena Football** in the Superdome.... I'm as sold on **Arena Football** as ever. It's a sport of the future.... The Hartford Courant 12/22/92

Right up there with **Arena Football** and the ballet - the professional comedy circuit suffers the ignominy of disinterest in New Orleans. The New Orleans Times 2/24/93

Once the sport all others envied, baseball has fallen on such hard times even **Arena Football** gets more respect. The Phoenix Gazette 3/7/93

Arena League football is a game with an attitude... And **Arena Football** apparently is a sport/entertainment that is here to stay as it enters its seventh season. Orlando Sentinel Tribune 5/13/93

Most of the emphasis will be on low-spectator sports like motorcycling, skiing, volleyball and **Arena Football**.... The Atlanta Journal and Constitution 6/8/93

The plan is to hire marketing people with experience in minor sports such as **Arena Football**, soccer and minor-league baseball, basketball and hockey.... The Buffalo News 11/14/93

The future of **Arena Football** and volleyball were also discussed at length. Amusement Business 1/31/94

And I'm not talking pseudo-pro sports such as **Arena Football** or the CFL or MISL or indoor lacrosse. Newsday 6/26/94

Arena Football, which had a one-season exposure in Sacramento in 1992, could be on the way back as early as 1996 at Arco.... Sacramento Bee 3/8/95¹¹

Examples of uses in which only the initial letter in ARENA capitalized are listed below:¹²

¹¹ There is also one instance of a mixed use, appearing in a newspaper question and answer format. That instance is listed below:

Q: I recently attended my first **arena football** game at the Suncoast Dome.... Gary L. Gilchrist, Palm Harbor
We went to Storm owner Bob Gries for an answer. His reply: "... That's a big part of what we promote in **Arena Football**...." St. Petersburg Times 8/7/92

¹² In about half of these cases, ARENA is the first word in the sentence. We have included examples of these uses as well, but regard them as essentially neutral, because there is no way of determining whether the author would have capitalized the first letter of ARENA if the term had appeared in the middle, rather than at the beginning, of a sentence.

... Walton is again enchanted with football and plans to return to **Arena football** as long as the new sport thrive. The New York Times 7/17/87

"**Arena football** gives us national exposure to a sport that is growing in popularity and was well-received in its first year," said Hardee's spokesperson Jerry Singer. ADWEEK 4/25/88

Arena football is another cable sports concoction. The Seattle Times 7/7/91

Arena football, of course. In case the sport is unfamiliar to you.... St. Louis Post-Dispatch 6/18/92

He drew the line at **Arena football**, a sport in which his hometown also is blessed with a franchise. Newsday 8/5/92

The Suncoast Dome is more for tractor pulls than baseball. The biggest attraction has been **Arena football**. The Sacramento Bee 8/11/92

He later was a replacement player with the Minnesota Vikings during the 1987 strike and also played **Arena football**. Chicago Tribune 10/9/92

"It's a magnificent facility," he said, noting that it has been used for tennis matches, basketball games, **Arena football** and concerts. St. Petersburg Times 11/11/92

Other new programming includes ... more coverage of skiing, **Arena football**, volleyball and "extreme sports," such as skysurfing. Newsday 6/8/93

After perusing the nicknames of the Big Four in hybrid sports--World TeamTennis, **Arena football**, Roller Hockey International and the Continental Indoor Soccer League--it appears that almost everyone was clear on that concept. The Houston Chronicle 7/18/93

Meat and potatoes fare like pro hockey, college basketball and **Arena football** will be

supplemented by a dose of the sports equivalent of bean sprouts--windsurfing, hang gliding....
The Washington Post 10/1/93

Among "minor" sports, **Arena football** leads in attendance. Average attendance in 1993 for an **Arena** game was 11,533. The Arizona Republic 7/5/94

"**Arena football** and the sports that are played here now through the summer don't bring a lot of out-of-town, overnight guests. Baseball does," she said. The Phoenix Gazette 3/10/95

The league's most valuable player in 1993, Cooper bristles at the words "trash sport."
"**Arena football** is more physical, more demanding on your body, than the NFL or Canadian Football League," said Cooper....
The Phoenix Gazette 6/17/95

Arena football is a fast-paced, high-scoring version of the sport played with eight players per side on a 50-yard field. The Commercial Appeal (Memphis) 10/1/94¹³

¹³ There are also two instances in which the term ARENA appears at the beginning of a sentence, and the first letter thereof is capitalized, but the designation ARENA FOOTBALL appears also in the middle of a sentence without capitals. Because of the nature of the use made in these two instances, listed below, we believe that they are examples of generic use:

"Everyone from George Strait to Neil Diamond, it seems, has played in the America West Arena since it opened in June. **Arena football**, team tennis and roller hockey have all been featured there. ... Everything else was terrific, in terms of concerts, **arena football**, team tennis, but there's nothing like the first (basketball) game for us," Colangelo said. The Arizona Republic 10/19/92

Arena football, recently proposed for the Civic Center, would provide the city's ever-deteriorating downtown with half a dozen little jolts of energy.... Having seen **arena football** on ESPN -- a few minutes here, a few minutes there, and always after midnight.... **Arena football** team ownership by the same people who own the pro basketball and hockey

The final piece of evidence relied upon by the Examining Attorney is an entry from R. Hickok, The Encyclopedia of North American Sports History (1992).¹⁴ The encyclopedia entry reads, in its entirety, as follows (**emphasis** in original for title, but added for text):

Arena Football

A made-for-TV sport, **arena football** was invented in 1987 by James Foster, who founded Arena Sports Ventures Un Limited to operate

teams is desirable.... The Hartford Courant 12/7/92

¹⁴ At oral hearing, counsel for applicant questioned whether the encyclopedia entry was timely made of record. A review of the three application files reveals that in application Serial Nos. 74/249,309 (ARENA FOOTBALL and design) and 74/249,318 (ARENA) the encyclopedia entry was made of record with the Examining Attorney's response to applicant's request for reconsideration of the final refusal to register. This submission was clearly timely. See §1207.04 of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"). In application Serial No. 74/249,469 (ARENA FOOTBALL), the encyclopedia entry was made of record by the Examining Attorney after appeal, but while the application was before the Examining Attorney upon remand for refusal of registration on an additional ground (subsequently withdrawn), namely, lack of ownership. The Examining Attorney's request for remand to assert the new ground was prompted by material submitted with applicant's request for reconsideration and notice of appeal. Upon remand, the Examining Attorney responded to applicant's request for reconsideration, submitted additional NEXIS evidence in support of the Section 2(e)(1) refusal, and asserted the new ground of refusal. Applicant filed a response thereto, arguing both grounds for refusal. The Examining Attorney then withdrew the lack of ownership refusal, but continued the Section 2(e)(1) refusal. The encyclopedia entry was submitted with this action. Under the circumstances, we consider the encyclopedia entry to have been timely submitted in this case also. See TBMP §§1207.04 and 1207.05. In view of the foregoing, the Examining Attorney's request (made at the time of the submission of the encyclopedia entry in each case) that we take judicial notice of the entry is moot, although we have authority to do so (see, for example, *B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988), and *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993)) and would, if necessary.

the Arena Football League. **Arena football** is played indoors on a 50-yard field, with eight players per team. The sport incorporates several gimmicks, including a field-wide net at each end of the playing area. On kickoffs and missed field goals, the ball remains in play when it hits the net. A dropkicked field goal is worth four points and a dropkicked conversion is worth two points. The league was organized as a single corporation, with each team owner holding a limited partnership.

A "preview season" was played in 1987, with teams in Chicago, Denver, Pittsburgh, and Washington and a total of just 12 games. In 1988, only Chicago and Pittsburgh remained, but Detroit, Los Angeles, New England (Providence), and New York were added. Disappointed at low attendance and television ratings, owners attempted to wrest control of the league from Foster early in 1989, but were unsuccessful. With teams in Chicago, Denver, Detroit, Maryland, and Pittsburgh, the league played another abbreviated season that year, with a five-week schedule and three playoff games.

This brings us to applicant's evidence, which, like the Examining Attorney's evidence, is extensive.¹⁵ First, in support of its claim of distinctiveness, applicant has submitted three declarations by Jerry B. Kurz, its vice president.¹⁶ What follows is a summary of the salient information contained in the declarations.

¹⁵ Part of applicant's evidence bears on the ownership issue and need not be discussed herein.

¹⁶ The first declaration was submitted along with the applications when they were filed on February 25, 1992. The second declaration, with updated information, was submitted more than a year-and-a-half thereafter, in September of 1993 for Serial No. 74/249,469, and in November of 1993 for the other two applications. The third declaration, which pertains primarily to the ownership issue, but also includes some updated information in support of applicant's claim of distinctiveness, was filed in Serial Nos. 74/249,309 and 74/249,318 in May of 1995.

The designations sought to be registered by applicant have been in continuous use since April 27, 1986, when the first indoor game played under the unique format and rules created by inventor James F. Foster was played in Rockford, Illinois. In the initial full season of games (June-August 1987), 12 regular season games and one championship game were played using the three designations on the field surface and in publicity materials used for games. Sweatshirts, T-shirts, hats, and pennants bearing the designations were sold at concession stands in the buildings. The games were played between teams owned by applicant's predecessor in interest in Chicago, Denver, Pittsburgh, and Landover, Maryland. Total attendance for the season, including the championship game, was 145,000. Gate receipts for that season, together with money earned from sales of licensed merchandise, endorsements, sponsorship payments and promotions totalled more than \$1.2 million.

In the second full season (May-July 1988), 36 regular season games, two playoff games, and a championship game were organized, promoted, and played under the designations sought to be registered. The games were played between teams headquartered in Chicago, Los Angeles, Detroit, New York, Pittsburgh, and the New England area. Total attendance was approximately 340,000. Gate receipts for the second regular season, excluding the playoff and championship games and the money earned from sales of

licensed merchandise, endorsements, etc. were estimated at approximately \$3 million.

Corporate sponsors for the first two seasons included Hardee's, Holiday Inn, Texas West, Inc., United Airlines, Nike, Wilson Sporting Goods, Budget Rent-A-Car, Hiram Walker, Little Caesar's, and Philip Morris.

A regular season of games (May-August) was played in each of the years 1989, 1990, 1991, 1992, 1993, and 1994. Since 1986, the games have been broadcast worldwide over the Prime Network, Canal Plus, and the ESPN network and have been watched by more than 70,000,000 viewers.

On August 20, 1993, the ArenaBowl 93 Championship game was broadcast throughout the world on ESPN and watched by an estimated one million viewers. The designation ARENA FOOTBALL was prominently displayed in the center of the field, and was visible throughout most of the TV broadcast of the game. In 1994, 21 league games were broadcast by ESPN and ESPN2, increasing broadcast exposure to more than 60 million homes in the U.S. Live attendance at games in the 1994 season topped 750,000.

By the end of 1993, teams playing in the Arena Football League¹⁷ and using the three designations sought to be registered had conducted games in 40 U.S. cities and four European cities. Over the seven full seasons, including playoff games, the teams performed live before a total of

¹⁷ Arena Football League, Inc. is the exclusive licensee of applicant.

more than 2,300,000 fans, and generated over \$40 million in ticket, sponsorship, and media revenues.

As of September 1, 1993, over 3,000 stories and articles about the League had been published nationwide and locally in magazines, newspapers, and wire services. Each of the stories reports facts ranging from the outcome of games to human interest items and the unique game played under the involved designations.

Mr. Kurz also states that since 1973, he has been involved with Minor League Football in the U.S. and Europe; that since 1986, he has represented the Arena Football League both in the U.S. and Europe by staging football games under the ARENA FOOTBALL mark; that in that time, he has traveled extensively throughout the U.S. and Europe, promoting and staging American football games; that that work included negotiationw with sponsors, TV, radio, print media, and advertising agencies; that those persons with whom he has dealt associate the mark ARENA FOOTBALL with the American football game played by teams in the Arena Football League; that in his experience, no other football league has ever played football games using the mark ARENA FOOTBALL; and that that mark is associated only with games organized, staged, and played by the Arena Football League and applicant.

Finally, Mr. Kurz's declarations contain assertions that the designations sought to be registered have become distinctive of applicant's services in commerce, being

recognized by the public as identifying applicant and its exclusive licensee, the Arena Football League, as the sole source of origin of said services.

Another piece of evidence submitted by applicant is the September 14, 1993 declaration of Robert N. Hillman, a self-employed, free lance journalist, broadcaster, and sports media consultant, who served from 1990-1992 as Director of Media Relations for the Arena Football League. The declaration indicates that since 1970, Mr. Hillman has been a principal sports anchor for network affiliate television stations in Tucson, Detroit, Cincinnati, and Chicago. In that time, he has also worked as a sports program producer and reporter for the NBC Today show and the USA Today "On TV" show. He presently has a video production company that produces sports news features, including a weekly feature for the NFL Chicago Bear football team, and he also has a radio talk show in Chicago. Mr. Hillman states that he considers himself to be knowledgeable regarding professional sports, especially football; that he has been aware of the professional sport of indoor football since 1987; that in his personal knowledge, indoor football contests using a short field and special rules and equipment, as used by the Arena Football League, have been organized and exhibited only by the Arena Football League (or its predecessor in interest); that these games have been played since at least 1987; that in all of these contests, the designation ARENA FOOTBALL has been used to identify this unique style of

football; that no other organization, to his knowledge, uses or ever has used ARENA FOOTBALL to identify any type of football game; that when he sees or hears the term ARENA FOOTBALL, he immediately thinks of the indoor football games played by the Arena Football League; that he believes that a substantial percentage of sports fans, especially football fans, have a similar opinion; that the term ARENA FOOTBALL identifies professional indoor football games played by teams of the Arena Football League in just the same way that the term NFL FOOTBALL identifies professional football games conducted by the National Football League; and that in his mind ARENA FOOTBALL is associated exclusively with the Arena Football League and applicant.

Also submitted in each application is a copy of the patent issued to applicant's predecessor, James Foster, and later assigned to applicant. The patent, No. 4,911,443, issued March 27, 1990, is entitled "FOOTBALL GAME SYSTEM AND METHODS OF PLAY."¹⁸

¹⁸ The first paragraph under the heading "BACKGROUND OF THE INVENTION" reads:

The invention relates to an apparatus and method for playing a game and more particularly to a new game incorporating many aspects of traditional American football.

The text under the heading "SUMMARY OF THE INVENTION" reads in part as follows:

It is the primary object of the invention to provide a variation of traditional American football that demands virtually all of the athletic skills of traditional football, but which is faster paced and which may be played inside existing sports facilities.

* * *

In accordance with the present invention, a new game involving the advancement of a ball across a playing field and over an opponent's goal line has

Other pieces of evidence submitted by applicant include the "1991 MEDIA GUIDE" mentioned above, in connection with applicant's uses cited by the Examining Attorney; the promotional sheet mentioned above; several different issues of its ARENABALL game magazine, mentioned above; a copy of a promotional video tape showing portions of games and featuring the designation ARENA FOOTBALL and design, as sought to be registered in application Serial No. 74/249,309; a copy of an unsolicited letter, dated May 24, 1993, from Sportcal Limited, a sports listing company in London, England, asking for a schedule of "Arena Football events" to include in its computerised calendar of international sports events; and dictionary definitions of the words "arena" and "football" (offered to show that ARENA FOOTBALL does not appear therein as the generic name of a game or type of sport) as well as a thesaurus entry for "arena."

Finally, applicant has submitted, in application Serial Nos. 74/249,309 and 74/249,318, copies of 10 articles. Two of the articles concern the JOCKEY trademark and are humorous in nature. These articles were offered by applicant to show the difficulty and frustration faced by

substantially the same rules as American football (e.g., NFL or NCAA) except that kicks or passes into the end zone may be deflected back onto the playing field as a "live" ball by a rebounding assembly that is proximate to the goal line, but elevated above the playing field. ...

the press when dealing with trademarks.¹⁹ The other eight articles were offered in support of applicant's argument, as specified on page 12 of applicant's request for reconsideration filed May 9, 1995, that "if a person were to refer generically to a type of football game played indoor, it would seem only logical, even common-sensical, that it would be referred to as 'indoor football.'"²⁰

¹⁹ One of the articles was written by Mike Royko and appeared in the February 17, 1995 issue of the Chicago Tribune. The second article was written by Dave Barry and appeared in the March 12, 1995 issue of the same newspaper.

²⁰ Applicant has highlighted certain portions of these articles. A story which appeared in the April 24, 1995 issue of The Hartford Courant concerns Merv Mosley, described in the article as "a first-team All-Arena Football League pick." The article also includes the following text highlighted by applicant:

In Arena Football, most players must play offense and defense. The game is played indoors on a field about the half size of a regular football field, with seven players to a side.

* * *

... "We have to teach them what the huddle looks like and what the positions are and what positions aren't because of the differences between the outdoor game. There is a lot of individual work.

An article appearing in the April 29, 1995 issue of The Commercial Appeal (Memphis) concerns "the Arena Football League's expansion Pharaohs" and "the Canadian Football League's expansion Mad Dogs." The article also includes the following text highlighted by applicant:

The Mad Dogs can boast they are playing real football, outdoors and on grass.

* * *

Arenaball is played on a small field where contact is king....

* * *

There may be, curiously, some small common ground on which they could play. Because the Liberty Bowl playing area isn't large enough for a CFL field, but one will be squeezed in anyway, the Memphis outdoor game may owe something to the wall-crashing indoor version. Think about it: We may be the first city to play Arena football outdoors.

* * *

A term is generic if it names the class or genus of the goods or services to which it is applied. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986), and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). The test for determining whether a term is generic is its primary significance to the relevant public, that is, whether the term is used or understood, by purchasers or potential purchasers of the goods or services at issue, primarily to refer to the class or genus of such

But what does it say about Arenaball that it is sold more as show biz than sport?

The remaining articles, and the portions thereof highlighted by applicant, are set forth below:

Bonner played at Northridge from 1987-90. He played last season with the Arizona Rattlers of the indoor Arena Football League. Los Angeles Times 3/11/95

Lary Kuharich, a long-time coach in American college football as well as in the Canadian Football League and the Arena League an indoor league, is coach of the Scottish Claymores. AP Worldstream 1/27/95

Another Falcons defensive assistant, Tim Marcum, will leave the team to become head coach of the Arena Football franchise in Tampa. The most successful coach in the indoor game, Marcum has won four Arena championships. The Atlanta Journal and Constitution 1/5/95

Can the Arena League (indoor football) share the building with baseball? St. Petersburg Times 3/10/95

The NHL has set no expansion timetable, but Bryan Colangelo, director of Phoenix Arena Sports, a Suns' subsidiary which operates indoor football and soccer teams, said PAS and the Suns hoped to have a [NHL] team within three years. AP Online 2/10/95

The first team to hit town will be the Memphis Pharaohs, who begin play next spring at The Pyramid in the indoor Arena Football League. The Commercial Appeal (Memphis) 12/25/94

goods or services. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra* and *In re Leatherman Tool Group, Inc.*, 32 USPQ2d 1443 (TTAB 1994). Evidence of the relevant public's understanding of a term may be obtained from any competent source, including consumer surveys, newspapers, magazines, dictionaries, catalogs, and other publications. See *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, *supra*, and *In re Northland Aluminum Products, Inc.*, *supra*. The Patent and Trademark Office has the burden of establishing that a term is generic by adducing "clear evidence" that the primary significance of the mark to the relevant public is that of a generic term for the specified goods or services. See *In re K-T Zoe Furniture Inc.*, 16 F.3d 390, 29 USPQ2d 1787 (Fed. Cir. 1994), and *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, *supra*. Any doubt on the issue must be resolved in favor of the applicant. See *In re Waverly Inc.*, 27 USPQ2d 1620 (TTAB 1993).

In the present cases, based on the evidence of record, we are convinced that the primary significance of the term ARENA FOOTBALL to the purchasers and potential purchasers of applicant's services is that of a generic name for a particular type of sport, that is, for indoor football played according to the rules developed by applicant's

predecessor, James Foster. We note, in this regard, that the DATATIMES and NEXIS article excerpts which demonstrate what we regard as clearly generic uses (examples of which are listed above at great length) outnumber all of those which show use of ARENA FOOTBALL with the first or both initial letters capitalized (even when the excerpts with these two types of uses are counted together, including those in which only the initial letter in ARENA is capitalized, and ARENA is the first word in the sentence) by a substantial margin; and that while the uses with one or both initial letters capitalized predominated in the DATATIMES and NEXIS excerpts for the years 1987 and 1988 (applicant's first two full seasons of games), the clearly generic uses predominated by a large margin (i.e., by a ratio of approximately 3:1) by the years 1994 and 1995. The 1992 encyclopedia entry made of record by the Examining Attorney confirms and bolsters the DATATIMES and NEXIS article excerpt evidence.²¹ In short, the record presents a picture of a term which, at the time of its first use, may have had some degree of recognition as a trademark²² (notwithstanding its highly descriptive nature) for

²¹ Prior to the Examining Attorney's submission of the encyclopedia entry, applicant made much of the fact that the Examining Attorney's evidentiary record consisted only of the DATATIMES and NEXIS article excerpts, which applicant regarded as circumstantial evidence, at best. Applicant argued that if ARENA FOOTBALL and ARENA were indeed generic, there would be direct evidence, such as dictionary and encyclopedia references, of that fact.

²² We note in this regard that just as it is true that the authors of articles sometimes misuse trademarks, it is also true that they sometimes capitalize terms that are not trademarks.

applicant's services, but which over the years has come to be used and perceived primarily as a generic designation, that is, has fallen into the lexicon of the language generally employed to designate a particular type of football.²³ Of course, this is the very type of football game which applicant organizes, schedules, and conducts. Under the circumstances, the designation ARENA FOOTBALL names the genus of applicant's services.

In arriving at this conclusion, we have carefully considered applicant's evidence and arguments (some of which are discussed below), but do not find them persuasive of a different result.

In support of its position that ARENA FOOTBALL is not generic and has become distinctive of its services in commerce, applicant has submitted, inter alia, two affidavits, one from a present officer and one from a former employee, concerning the length and extent of its use of this designation. These are certainly two factors to be considered, and applicant's evidence thereon is impressive. However, the nature of the designation and of applicant's use thereof, and the resulting public perception of the designation, are even more critical. Here, applicant

²³ It may well be that one reason why this happened is that applicant itself used the term ARENA FOOTBALL as a noun, without any accompanying generic designation. Indeed, many of the article excerpt uses where the first or both initial letters in the words ARENA FOOTBALL are capitalized are of this same nature. Further, the record is devoid of evidence that applicant has taken any action to police the term ARENA FOOTBALL with respect to generic uses.

selected a descriptive designation, and, as shown by the other materials submitted by applicant, made frequent use of the designation as a noun, with no accompanying generic term. In the case of *Remington Products Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444 (Fed. Cir. 1990), the Court, citing *In re Thunderbird Products Corp.*, 406 F.2d 1389, 160 USPQ 730 (CCPA 1969) (wherein CATHEDRAL HULL was refused registration for boats because the term had entered into general usage to designate a type of boat hull), the Court stated, at 1449:

It is very easy for marks consisting of common, simple English words having connotations related to the products on which they are used, their properties, or uses to slip out of their origin-indicating role and into the vernacular as descriptive terms and once that happens the possibility of registration as trademarks under the Lanham Act vanishes.

The DATATIMES and NEXIS article excerpts and encyclopedia entry made of record by the Examining Attorney indicate that that is exactly what has happened in this case.

Applicant relies on the case of *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, *supra*, which involved a refusal to register similar to that asserted herein, with voluminous evidence of usage in publications of the term sought to be registered. The Board affirmed the Examining Attorney's refusal to register, but the Court reversed. It appears, however, that the evidence in that case was more evenly split between generic significance and trademark significance than is the evidence in this case. Moreover,

and most significantly, there is no indication that the evidentiary record in that case showed the same type of pattern as that demonstrated in this case, that is, a pattern of growth of generic significance over a period of years until it predominated by a large margin. Cf. *In re Northland Aluminum Products, Inc.*, *supra*.

Similarly unpersuasive is applicant's argument that ARENA FOOTBALL identifies professional indoor football games played by teams of the Arena Football League in just the same way that the term NFL FOOTBALL identifies professional football games conducted by the National Football League. ARENA FOOTBALL inherently is a descriptive designation as used in connection with applicant's services, whereas NFL FOOTBALL is not in this category and creates a different type of commercial impression.

Applicant also argues that "indoor football" is the logical generic for football games played indoors. However, it is well established that a product or service may have more than one generic designation, and that each belongs in the public domain, and must remain free of proprietary claims. Although applicant's game rules and system are presently covered by its patent, and its use has therefore been essentially exclusive to date, when the patent expires,²⁴ other entities will be free to organize, schedule

²⁴ Applicant's own materials emphasize the importance of the patent, and the exclusivity that it confers, to the value of its teams and the stability of its league.

and conduct football games similar in nature to applicant's. The evidence of record suggests that when they do, it is the designation ARENA FOOTBALL which will best serve to describe the genus of their services.²⁵ As stated by the Court of Appeals for the Second Circuit in *CES Publishing Corp. v. St. Regis Publications, Inc.*, 531 F.2d 11, 188 USPQ 612, 615 (1975):

To allow trademark protection for generic terms, i.e., names which describe the genus of goods being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.

Applicant argues that in most of the article excerpts made of record by the Examining Attorney, the author was discussing the activities of applicant or its licensees, either directly or indirectly. While this may well be so (and is not surprising, in view of applicant's patent), it does not follow therefrom that any use of ARENA FOOTBALL in those excerpts is necessarily a service mark use.

In summary, we are convinced, having considered all of the evidence of record, that the designation ARENA FOOTBALL

²⁵ Applicant itself notes, in its request for reconsideration of May 9, 1995, that the National Football League and the Canadian Football League play some of their football games in indoor facilities or stadiums. However, the type of "indoor football" which these leagues offer differs from that offered by applicant. If, in the future, competitors wish to offer football games of the type offered by applicant under its patent, it seems to us that they will need to use the term ARENA FOOTBALL to generically describe their indoor football services, as distinguished from the indoor football services offered by the National Football League and the Canadian Football League.

is generic for applicant's services, and therefore is not registrable. *Cf. Loglan Institute Inc. v. Logical Language Group Inc.*, 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992); *In re Wallyball, Inc.*, 222 USPQ 87 (TTAB 1984); and *In re Sports Tigers*, 213 USPQ 670 (TTAB 1982). We add, in case we are ultimately reversed on this issue, that the strong evidence of generic significance leads us to conclude that applicant has failed to prove *prima facie* that the designation ARENA FOOTBALL has become distinctive of its services.²⁶

As to the designation ARENA, this designation is used by applicant not alone, but rather in combination with the term FOOTBALL, that is, as part of the generic designation ARENA FOOTBALL. Under the circumstances, we agree with the Examining Attorney that the primary significance which ARENA projects is that of a generic adjective, and that it is therefore unregistrable. *Cf. In re Northland Aluminum Products, Inc.*, *supra*; *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281 (7th Cir. 1977), *cert. denied*, 434 U.S. 1025, 196 USPQ 592 (1978); *In re Sun Oil Co.*, 426 F.2d 401, 165 USPQ 718 (CCPA 1970); and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:10 (4th ed. 1996). And again we add, in case we are ultimately reversed on this issue, that the

²⁶ We note, in this regard, that applicant has submitted declarations from a current and former employee, but no survey or declarations from purchasers or potential purchasers regarding their perception of the designations sought to be registered.

strong evidence of generic significance leads us to conclude that applicant has failed to prove prima facie that the designation ARENA has become distinctive of its services.

We note, as a final comment, that it may well be that ARENA FOOTBALL LEAGUE is a source identifier for applicant's services, but that issue is not before us.

Decision: The refusal to register in application Serial Nos. 74/249,318 and 74/249,469 is affirmed. The requirement in application Serial No. 74/249,309 for a disclaimer of ARENA FOOTBALL is also affirmed. Should applicant submit the required disclaimer in application Serial No. 74/249,309 within thirty days from the mailing date of this decision, the decision with respect to that application will be set aside, and the application will be published for opposition.

J. E. Rice

E. W. Hanak

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board